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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,003	04/23/2004	Ingrid Schemmel	P24945	7650

7055 7590 08/08/2007
GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

ZHU, WEIPING

ART UNIT	PAPER NUMBER
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1742

NOTIFICATION DATE	DELIVERY MODE
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08/08/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/830,003	Applicant(s) SCHEMME ET AL.	
	Examiner Weiping Zhu	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 18-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 28-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-17 and 28-39 are currently under examination, wherein claims 3, 4, 29 and 30 have been amended in applicant's amendment filed on May 29, 2007. The applicant affirmed the provisional election of the Invention of I, claims 1-17 and 28-39 made with traverse over the phone on February 20, 2007 in the same amendment. The Invention II, claims 18-27 has been withdrawn as being drawn to a non-elected invention, wherein claim 19 has been amended.

Applicant's election with traverse of Invention I, Claims 1-17 and 28-39 in the reply filed on May 29, 2007 is acknowledged. The traversal is on the ground(s) that the searches for Inventions I and II should significantly overlap and therefore there is no serious burden for the examiner. This is not found persuasive because as stated in the Office action dated February 28, 2007 the invention I is a cold work steel article and the invention II is a process for producing a cold work steel article. They are independent or distinct and have acquired a separate status in the art in view of their different classifications. There would be a serious burden on the examiner if restriction is not required

The requirement is still deemed proper and is therefore made FINAL.

Status of Previous Rejections

2. The previous objection to claims 3 and 4 for informality is withdrawn in light of applicant's amendments filed on May 29, 2007. The previous rejections of claims 1-17

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and 28-39 under 35 U.S.C. 103(a) as stated in the Office action of February 28, 2007 are maintained as follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 and 28-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-055747 as stated in the Office action of February 28, 2007.

With respect to the amended features of claims 3, 4, 29 and 30, they do not change the scope of the claims. Therefore, the reasons for the rejections as stated in the Office action of February 28, 2007 are properly applied herein.

Response to Arguments

4. The applicant's arguments filed on May 29, 2007 have been fully considered but they are not persuasive.

First, the applicant argues that JP ('747) teaches a different steel composition than the instant invention and all of the ranges do not overlap; The total weight percentage of W and Mo of JP ('747) is required to satisfy $(2\text{Mo} + \text{W}) = 15\text{-}30\%$ and this requirement is reflected in all six examples of JP ('747); In contrast, the highest value of $(2\text{Mo} + \text{W})$ for the instant invention is 11%, which does not overlap the lowest value of JP ('747) of 15%. In response, the examiner notes that the rejection was based on the prior art's broad disclosure rather than preferred embodiments. JP ('747) discloses that

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the steel composition comprises by weight 1-20% of W and 1-10% of Mo (abstract), which overlap the claimed 1.8-3.4 wt. % of W and 1.9-3.8 wt. % of Mo respectively. As stated in the Office action of February 28, 2007, the overlapping establishes a prima facie case of obviousness. See MPEP 2144.05 I. It would have been obvious to one skilled in the art to have selected the claimed ranges within the disclosed ranges of JP ('747), because JP ('747) discloses the same utility over the whole disclosed ranges.

Second, the applicant argues that the amount of carbide in the steel of JP ('747) would be much higher than that in the instant invention due to the higher contents of carbide-forming elements present in the steel of JP ('747); therefore, the properties of the steel of JP ('747) would be completely different from those of the instant invention. In response, see the response to the applicant's first argument above.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WZ

7/29/2007


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700